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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,213	03/31/2004	Matthew Paul Duggan	AUS920040010US1	7107
34533 7590 04/11/2008 INTERNATIONAL CORP (BLF) c/o BIGGERS & OHANIAN, LLP P.O. BOX 1469 AUSTIN, TX 78767-1469				
EXAMINER				
KIM, JUNG W				
ART UNIT		PAPER NUMBER		
2132				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/815,213

Applicant(s)

DUGGAN ET AL.

Examiner

JUNG KIM

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office action is in response to the amendment filed on 1/16/08.
2. Claims 1-28 are pending.

Response to Arguments

3. Applicant's arguments have been fully considered but they are not persuasive.
4. With respect to the 101 rejections, applicant argues that the instant claims are directed to statutory subject matter because the current law holds that a "storage medium" having stored there on are directed to statutory subject matter. (See Remarks, pgs. 2-3). Granted, a claim claiming a "storage medium" or "computer-readable medium" are on face value presumed to be statutory subject matter. However, this argument is insufficient because applicant provides a definition that expands the ordinary meaning of the term to include nonstatutory subject matter; i.e. when the specification defines the medium in question as transitory in nature, the medium claimed is not statutory (In re Nuijten, No. 06-1371 (Fed. Cir. 2007), pg. 11 ["Nuijten and the PTO agree that the claims include physical but transitory forms of signal transmission such as radio broadcasts, electrical signals through a wire, and light pulses through a fiber-optic cable, so long as those transmissions convey information encoded in the manner disclosed and claimed by Nuijten. We hold that such transitory embodiments are not directed to statutory subject matter"]). Here, Applicant has claimed a product comprising a recording medium. (claim 19) Applicant further defines

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that "[e]mbodiments of a computer program product may be implemented by use of any recording medium for machine-readable information, including magnetic media, optical media, **transmission media**, or other suitable media." (pg. 6) As held in Nuijten, transmission media is not recognized as one of the four categories of statutory subject matter.

5. With respect to the 102 rejections, applicant argues:

Botz's user identity mapping mechanism, however, does not disclose receiving from a system entity, in a security service, security information in a native format of a first security domain regarding a system entity having an identity in at least one security domain and returning to the system entity the security information in the native format of the second security domain as claimed in the present application because Botz's user identity mapping mechanism operates exclusively within a single domain to correlate a user's local user identities stored in different user registries within the single domain. Botz at column 9, line 59, states that a domain "represents a logical division for managing user identities." Botz then goes on to describe how a global identifier for a user is used to map a user's local identity in a user registry within a domain to that user's local identity in a different user registry within the same domain. See Botz at column 9, line 59, through column 10, line 25, and Figure 14. That is, Botz never receives security information in a native format of a first security domain and returns the security information in the native format of a second security domain as claimed in the present application because Botz is only concerned with mapping user identities among registries within a single domain. Because Botz does not disclose each and every element and limitation of Applicants' claims, Botz does not anticipate Applicants' claims, and the rejections under 35 U.S.C. § 102 should be withdrawn. (pg. 6)

6. Applicant's argument is not persuasive because Botz's invention functionally suggests the relevant limitations of the claims. Although Botz does disclose the mapping mechanism within a single domain as indicated by applicant, the "domain" as defined by Botz is not limiting as suggested by the applicant. A domain, as taught by Botz, does not define security divisions as claimed in applicant's claims. Rather, the domain of Botz's invention defines general logical divisions ("The domain 1410 represents a logical division for managing user identities. A domain 1410 can be a company, a division within a company, a building within a division, or any other division that indicates a physical relationship. Furthermore, a domain 1410 can be strictly logical

divisions, such as hourly employees and salaried employees," col. 9:60-65) As outlined in the rejections below, applicant's claimed recitation of a native format of a first and second security domains are in fact suggested by the various environments which utilize different security protocols (see fig. 10). As taught by Botz, each local user identity on their respective security environments is mapped to the other local user identities via an enterprise identifier. (col. 9:46-54) For these reasons, Botz anticipates claims 1-6, 10-15, 19-24 and 27.

7. Finally, with respect to applicant's allegations that Botz does not disclose other limitations of the claims (see pg. 9), these arguments are merely conclusionary and do not provide any rational why the limitations are not suggest by the prior art. Such a response does not adequately rebut a prima facie case for rejection of the claims. Hence, claims 7-9, 16-18, 25, 26 and 28 remain rejected under the prior art of record.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims do no restrict the claimed invention to statutory classes of invention. Rather, the specification defines computer program products embodied on a recording medium to encompass transmission media. (See Specification, pg. 6, line 22) Hence, these claims are limited to statutory subject matter.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-6, 10-15 and 19-24 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Botz et al. USPN 6,981,043 (hereinafter Botz).

11. As per claims 19-24 and 27, Botz discloses a computer program product for cross domain security information conversion (figs. 14, 15 and 22), the computer program product comprising:

- a. a recording medium; (fig. 6)
- b. means, recorded on the recording medium, for receiving from a computer program product entity, in a security service, security information in a native format of a first security domain regarding a computer program product entity having an identity in at least one security domain; (14:17-30)
- c. means, recorded on the recording medium, for translating the security information to a canonical format for security information;
- d. means, recorded on the recording medium, for transforming the security information in the canonical format using a predefined mapping from the first security domain to a second security domain; (9:46-54; fig. 10)

- e. means, recorded on the recording medium, for translating the transformed security information in the canonical format to a native format of the second security domain (10:35-38 and lines 38-52; fig. 21 "RetrieveUser" and "RetrieveUserDefinition"); and
 - f. means, recorded on the recording medium, for returning to the computer program product entity the security information in the native format of the second security domain (14:30-34; fig. 21);
12. wherein means, recorded on the recording medium, for transforming the security information includes means, recorded on the recording medium, for structure transformation and value transformation, including means, recorded on the recording medium, for mapping a system entity's identity in the first security domain to a another identity in the second security domain; (figs. 16-21)
13. wherein means, recorded on the recording medium, for receiving security information further comprises means, recorded on the recording medium, for receiving a request for security information for the second security domain, wherein the request encapsulates the security information in a native format of a first security domain; (14:23-34)
14. wherein the computer program product entity comprises a computer program product entity requesting access to a resource in the second security domain; (14:31-32)
15. wherein the computer program product entity comprises a computer program product entity providing access to a resource in the second security domain; (14:31-32)

16. wherein means, recorded on the recording medium, for translating the security information in a native format of a first security domain to a canonical format comprises a procedural software function; wherein means, recorded on the recording medium, for translating the transformed security information in the canonical format to a native format of the second security domain comprises a procedural software function (figs. 16-21, "APIs")

17. As per claims 1-6, they are claims corresponding to claims 19-24 and 27, and they do not teach or define above the information claimed in claims 19-24 and 27. Therefore, claims 1-6 are rejected as being anticipated by Botz for the same reasons set forth in the rejections of claims 19-24 and 27.

18. As per claims 10-15, they are claims corresponding to claims 19-24 and 27, and they do not teach or define above the information claimed in claims 19-24 and 27. Therefore, claims 10-15 are rejected as being anticipated by Botz for the same reasons set forth in the rejections of claims 19-24 and 27.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 7-9, 16-18, 25, 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Botz in view of Bussler et al. USPN 7,072,898 (hereinafter Bussler).

21. As per claims 25, 26 and 28, the rejections of claims 19-24 and 27 as being anticipated by Botz are incorporated herein. Botz does not disclose expressing the first native format, the canonical format nor the second native format in XML, whereby security information is translated between the first native format and the second native format via the canonical format via XSL. Bussler discloses an apparatus for exchanging communications between heterogeneous applications wherein data items go through five processes between a source and destination: 1) source-side native phase, 2) source-side application phase, 3) common view phase, 4) target-side application phase, and 5) target-side native phase, whereby the source-side application phase, common view phase and target-side application phase utilize XML to express the data from the source-side application to the target-side application and vice versa. (3:60-4:43; 5:15-7:51) Furthermore, XSL is the standard means of defining transformations of an XML file. Finally, Bussler discloses that the invention overcomes deficiencies of prior inventions, which centralize integration procedures, by disbursing the integration over the several participants of the communication. (2:30-36) Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made for the computer program product of Botz to further include wherein means, recorded on the recording medium, for translating the security information in a native format of a first security domain to a canonical format comprises a mapping, expressed in XSL, from the native

format of the first security domain to a canonical format; wherein the canonical format is expressed in XML and the predefined mapping from the first security domain to a second security domain is expressed in XSL; wherein the second native format is expressed in XML, the canonical format is expressed in XML, and means, recorded on the recording medium, for translating the transformed security information in the canonical format to a native format of the second security domain comprises a predefined mapping, expressed in XSL, from the canonical format to the native format of the second security domain. One would be motivated to do so to disburse the integration over the several participants of the communication, thereby reducing the complexity of the conversion (Bussler, 2:30-36) The aforementioned cover the limitations of claims 25, 26 and 28.

22. As per claims 7-9, the rejections of claims 25, 26 and 28 under 35 USC 103(a) as being unpatentable over Botz in view of Bussler are incorporated herein. In addition, Bussler discloses wherein the native format of the first security domain is expressed in XML. (col. 6:3-34) One would be motivated to combine the teachings of Bussler with the invention of Botz to disburse the integration over the several participants of the communication, thereby reducing the complexity of the conversion (Bussler, 2:30-36). The aforementioned cover the limitations of claims 7-9.

23. As per claims 16-18, they are claims corresponding to claims 25, 26 and 28, and they do not teach or define above the information claimed in claims 25, 26 and 28.

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Therefore, claims 16-18 are rejected as being unpatentable over Botz in view of Bussler for the same reasons set forth in the rejections of claims 25, 26 and 28.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Communications Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUNG KIM whose telephone number is (571)272-3804. The examiner can normally be reached on FLEX.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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